

Remarks

By the above Amendments, the Applicant has replaced pending claims 16 through 33 with amended claims 16 through 35. New claims 34 and 35 were added to recite the allowable subject matter identified in paragraph 3 on page 3 of the subject Office Action. The Applicant acknowledges with appreciation Examiner Dexter's assistance in identifying this allowable subject matter. No new matter was introduced.

Claims 16 through 35 are pending in this application.

Entry of these Amendments, reconsideration of the claims presented in this Office Action, and allowance of the claims now pending are respectfully requested.

Response to 103 Rejection based upon Granger '035

In paragraph 2 on pages 2 and 3 of the Action, the Patent Office rejected claims 16-33 under 35 USC §103(a) as obvious in view of US patent 4,846,035 of Granger [herein "Granger '035"] and with what the Patent Office contends is knowledge which is "old and well known in the art." However, the Applicant respectfully submits that these rejections are inappropriate, and requests that the Patent Office reconsider these rejections in view of the following.

First, Granger '035 is essentially the same prior art as U.S. patent 4,635,837 of Granger (herein "Granger '837") that was the subject of a previous 103(a) rejection. Since no rejections appear based upon Granger '837 in the present Office Action, the Applicant assumes that the earlier rejection based upon Granger '837 has been overcome. The Applicant submits that Granger '035 is not significant to the patentability of the present invention for the same reasons that Grange '837 was not significant. These reasons were outlined in the Response filed on December 19,

2003. These reasons are not included here for the sake of brevity (but are incorporated by reference herein), but may be summarized as:

1) The sole inventor whose name appears on Granger '035 is the very same inventor whose name appears on the present application. Mr. Maurice Granger, a recognized expert in the field of this invention (as attested to by the 43 U.S. patents listed in the previous response), is quite familiar with the art of his own Granger '035 and, in particular, the deficiencies of his own Granger '035.

2) In lines 13-15 on page 1 of the present specification, Mr. Granger identifies the prior art European Patent No. 145, 622 [herein "EP '622"] and the deficiencies of this prior art. Granger '035 has essentially the same deficiencies as EP '622 and Granger '837 discussed on pages 2 and 3 of the present specification.

3) The deficiencies of Granger '035 were only recognized by Mr. Granger. These deficiencies of the prior art were not recognized by of EP '622, Granger '837, or Granger '035. These deficiencies of the prior art are only recognized by Mr. Granger and were then successfully addressed only by the present invention.

For these reasons alone, the Applicant submits that these rejections of claims 16 and 31 and their dependents are inappropriate.

Response to "old and well known art"

In paragraph 2 on page 2 of the Action, the Patent Office first recognizes the deficiencies of the teachings of Granger '035; namely, Granger '035 fails to teach that "the central section having a length greater than the width of the at least one groove of

the drum". The Patent Office attempts to overcome this deficiency by taking official notice that this feature is "old and well known in the art." Again, the Applicant respectfully submits that this rejection is inappropriate and requests that this rejection be reconsidered and withdrawn.

First, the Applicant submits that it is inappropriate to extract a limitation of claim 16 and 31 out of context without considering the function of this limitation, which is expressly recited in claim 16 and 31. Contrary to the implications of the statements made by the Patent Office in the subject Office Action, the central section is not simply made wider than the groove in the drum simply for the sake of making it wider. As recited in the final clause of claims 16 and 31, the central section is made wider to ...allow[] the at least one belt to deflect laterally over an amplitude ( $\alpha$ ) when a paper strip is pulled laterally from the paper strip dispensing apparatus.

As recited in lines 14-19 on page 7 of the specification, this lateral deflection "makes it possible to use the dispensing machine in any situations where the strip of material is pulled sideways without the machine thereby being jammed." [Emphasis added.]

Thus, the Patent Office's contention that it would be obvious to employ a wider central section for "compensating manufacturing tolerances" or for "facilitating interchangeability of parts" fails to consider the role of this limitation, as expressly recited in the claims, and disclosed nowhere in the prior art.

Clearly, as expressly recited in claim 16 and 31, the width of the central section relative to the width of the groove in the drum provides a beneficial function that is not disclosed, taught, or even suggested in Granger '035, and has nothing whatsoever to do with manufacturability or the interchangeability of parts. Again, the Applicant submits that these rejections be reconsidered and withdrawn.

Second, the applicant traverses the Patent Office's assertion that this feature of claims 16 and 31 is "old and well known in the art." As the Patent Office is aware,

basing a rejection on claimed "old and well known in the art" is carefully governed by guidelines provided in the MPEP and case law. Specifically, § 2144.03 of the MPEP summarizes:

Any rejection based on assertions that a fact is well known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421. [Emphasis added.]

In the present Office Action, the Patent Office provides absolutely no evidentiary evidence in support of this rejection.

Moreover, recently in *In re Lee*, the Federal Circuit further emphasized that when evidence is cited in support of an obviousness rejection, the evidence must be "based upon objective evidence of record." *In re Lee*, 277 F. 3d 1338, 61 USPQ2d at 1433 (Fed. Cir. 2002). Clearly, in the present rejection, no objective evidence is provided in support of the Patent Office's rejection.

Since the Patent Office provides no evidence whatsoever, objective or otherwise, concerning desirability of having the central section of the claimed shaft wider than the than the groove in the drum, the Applicant respectfully submits that the rejection of claims 16 and 31 as obvious in view of Ganger '035 and what is incorrectly considered "old and well known" is inappropriate. The Applicant requests that these rejections be reconsidered and withdrawn.

Conclusions

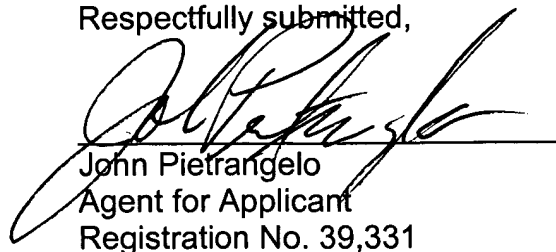
The Applicant submits that the rejections of claims 16-33 as obvious in view of Granger '035 and what is claimed to be "old and well know in the art" are inappropriate.

The Applicant believes that the application is in allowable form. Passage of the application to issue is earnestly solicited. Should any matters remain outstanding, it is requested that the undersigned Agent be given a call so that such matters may be worked out and the application placed in condition for allowance without the necessity of another Action.

Request for Interview

Again, if the Patent Office is still of the opinion that the subject matter of the pending claims does not constitute patentable subject matter, the Applicant requests an interview with the Examiner pursuant to section 706.07(b) of the MPEP.

Respectfully submitted,



John Pietrangelo  
Agent for Applicant  
Registration No. 39,331

Dated: June 22, 2004

HESLIN ROTHENBERG FARLEY & MESITI P.C.  
5 Columbia Circle  
Albany, New York 12203-5160  
Telephone: (518) 452-5600  
Facsimile: (518) 452-5579